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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,152	10/29/2003	Hans-Peter Broghammer	696.022	9623
23598	7590	10/06/2005	EXAMINER	
BOYLE FREDRICKSON NEWHOLM STEIN & GRATZ, S.C. 250 E. WISCONSIN AVENUE SUITE 1030 MILWAUKEE, WI 53202				CADUGAN, ERICA E
ART UNIT		PAPER NUMBER		
3722				

DATE MAILED: 10/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/696,152	BROGHAMMER ET AL.	
	Examiner Erica E. Cadugan	Art Unit 3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1)  Responsive to communication(s) filed on 13 July 2005.

2a)  This action is FINAL.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

- 4)  Claim(s) 1-23 is/are pending in the application.  
4a) Of the above claim(s) 7,13,15-18,20 and 22 is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) 1-6,8-12,14,19,21 and 23 is/are rejected.  
7)  Claim(s) \_\_\_\_\_ is/are objected to.  
8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 29 October 2003 is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3/29/04.  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. 09292005.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Note that DE 2700934, a brochure, and DE 29614727 are mentioned on pages 1-2 of the specification.

### ***Specification***

2. The abstract of the disclosure is objected to because it contains "legalese" such as "means" or "said". Correction is required. See MPEP § 608.01(b).

### ***Election/Restrictions***

3. Applicant's election without traverse of the embodiment or species of Figure 7, which reads on claims 1-6, 8-12, 14, 19, 21, 23 in the reply filed on July 13, 2005 is acknowledged.

Claims 7, 13, 15-18, 20, and 22 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on July 13, 2005.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claims 1-6, 8-12, 14, 19, 21, and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-6, 8-12, 14, 19, 21, and 23 are replete with instances that do not particularly point out and distinctly claim the subject matter of applicant's invention. Examples of these instances are listed below, but these instances are not limited to the listed examples. Applicant is advised to closely review the claims for other occurrences.

There are several positively recited limitations that lack sufficient antecedent bases in the claims. A few examples of this are: "the cutter" in claim 1, line 7 (previously "at least one..."); "the pressure transfer means" in claim 1, last line (previously "pressure means"), "the tool" in claim 4; etc. This is not meant to be an all-inclusive list of such occurrences. Applicant is required to review the claims and correct any other such occurrences of limitations lacking sufficient antecedent basis.

Throughout the claims, there is no axis or frame of reference for determining what is meant by "axially" or "radially".

In claim 9, it is unclear as set forth in the claim to what "it" refers.

As set forth in claim 10, it is unclear how the "adjustment device" includes a "characteristic diagram" as claimed. Examiner suggests deleting the language in lines 1-2 of claim 10 that states "comprising a characteristic diagram which provides", and substituting language such as --wherein there is-- therefor.

***Claim Rejections - 35 USC § 102***

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6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-6, 11-12, 14, and 23, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 6,270,295 to Hyatt et al.

Hyatt teaches a cutting tool 300 including a “cutter” 326 attached to a “cutter support” (see Figures 5-6, for example). A “pressure chamber” including 338, 342, 344, etc. (Figure 5) is provided spaced from the “cutter”, and, when fluid is supplied to the “pressure chamber” via conduit 308, the blade side 334 with the cutter attached thereto is moved radially (with respect to the longitudinal central axis of the tool) outward to thereby adjust the radial position of the “cutter” 326 (see Figures 5-6 and col. 10, line 49 through col. 11, line 33).

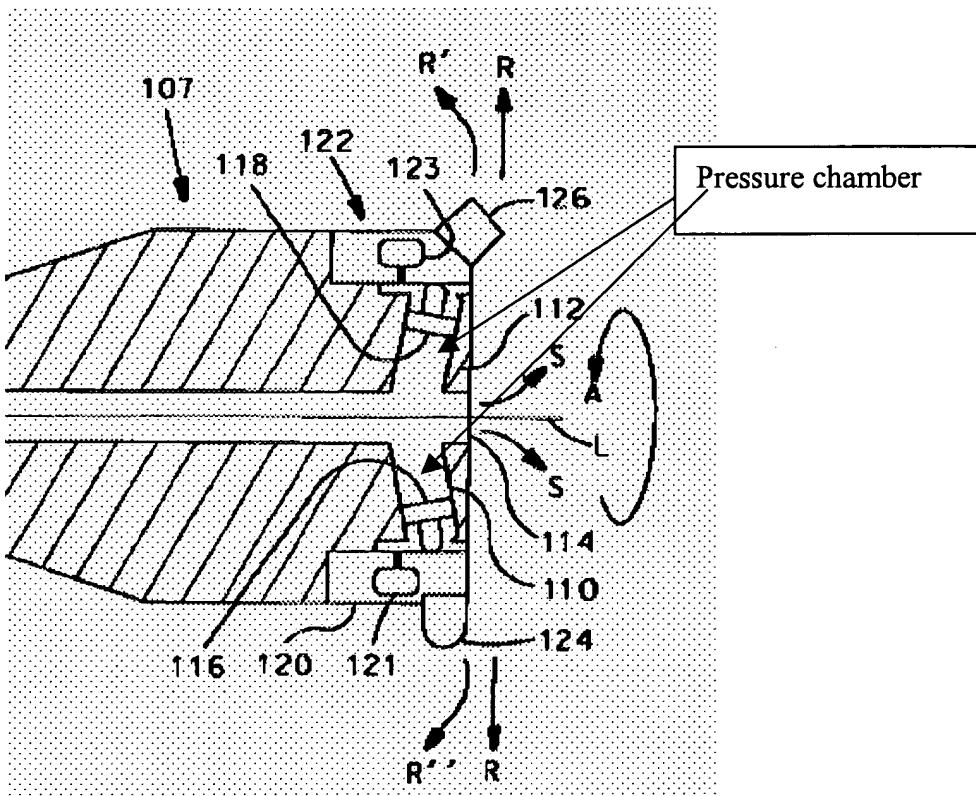
Note that the blade support or “wall” 334 “elastically deforms” under pressure of the fluid due to the slots 342, 344, and the area of removed material 340 (see col. 11, lines 7-13 and Figure 5, for example).

Note also that whatever device supplies the pressurized cooling fluid to create the movement of the cutter 326 as described above is considered to be the claimed “pressure generation device”.

Note also that the described pressure chamber is considered to be “arranged in the adjustment direction of the cutter” in that it is spaced radially therefrom as shown in Figure 5.

Re claim 2, see Figure 5.

Re claim 3, note that the other embodiments taught by Hyatt function similarly to the embodiment described above, and especially see Figure 1A (for example), noting that the axial length of the pressure chamber that is labeled in the partial reproduction of Figure 1A below appears to “correspond essentially” to the length of the cutter 126.



Additionally, re claim 4, it appears that in the embodiment of Figure 1A, the axial length of the aforescribed “pressure chamber” is “limited to the region of the tool corner”, as best understood.

Re claim 5, it is noted that the device described previously functions on the principle that the amount of cutter adjustment is based on the fluid pressure applied (see col. 11, lines 1-7, for example), and thus, the elastic deformation between the pressure chamber and the cutter inherently “lies in the size range of the cutter adjustment”.

Re claim 6, see col. 7, lines 61-65, which fluids are considered to be “at least approximately incompressible”.

Re claim 12, it is noted that via the exit conduit 114 shown in Figure 1A, the pressure chamber shown above can be considered to be “ring” shaped.

Re claim 14, the cutter support described previously is considered to constitute a “tool mounting basic element”, as broadly claimed, in that it serves to “mount” a tool thereon.

Re claim 23, the “tool” 300 described previously is considered to be a “fine” machining tool, as broadly claimed (see especially col. 2, lines 58-62, noting that the device taught by Hyatt is used to “accurately” machine, and that the tool diameter is expandable “uniformly and selectively”).

***Allowable Subject Matter***

8. Claims 8-10, 19, and 21 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erica E. Cadugan whose telephone number is (571) 272-4474. The examiner can normally be reached on M-F, 6:30 a.m. to 4:00 p.m., alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer D. Ashley can be reached on (571) 272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Erica E Cadigan  
Primary Examiner  
Art Unit 3722

ee<sup>c</sup>  
September 29, 2005